

REMARKS

In the Advisory Action, the Examiner declined to enter an affidavit that we submitted along with an Appeal Brief on April 2, 2009. Under 37 CFR 41.33, amendments and affidavits as well as other evidence can be submitted after appeal. An affidavit filed after the date of filing an appeal pursuant to §41.31(a)(1) through (a)(3) and prior to the date of filing a brief pursuant to 41.37 may be admitted if the Examiner determines that the affidavit overcomes all rejections under appeal and that a showing of good and sufficient reasons why the affidavit is necessary and was not earlier presented has been made.

Below we explain why the submitted affidavit satisfies the requirements of 37 CFR 41.33 and why it should be admitted by the Examiner. Specifically, we spell out (1) how the affidavit overcomes all rejections under appeal and (2) why the affidavit is necessary and was not earlier presented.

A. The affidavit overcomes all rejections under appeal

At present, there are three standing rejections covering various claims in the application. The three standing rejections are as follows:

1. Claims 1-19 stand rejected under 35 U.S.C. 103(a) over US Patent No. 6,207,625 (“Ogano”) in view of US Patent No. 3,893,168 (“Brehm”) or US Patent No. 2,833,717 (“Whitacre”);
2. Claims 1-9 and 11-19 stand rejected under 35 U.S.C. 103 over US Patent No. 6,444,624 (“Walker”) in view of US Patent No. 3,876,550 (“Holubec”) and further in view of US Patent No. 3,893,168 (“Brehm”) or US Patent No. 2,833,717 (“Whitacre”); and
3. Claims 1-19 stand rejected on the ground of nonstatutory obviousness-type double patenting over claims 1-14 of US Patent No. 6,642,188.

As stated in the appeal brief, the invention recited in independent claim 1 is a lubricating oil composition comprising a specific and novel rust inhibitor system in

combination with the other recited components. The specific and novel rust inhibitor system enables the lubricating composition to exhibit superior rust performance. The specific rust inhibitor system in claim 1 is not disclosed in any of the cited references. The affidavit submitted with the appeal brief contains data which confirms the superior rust performance of the claimed lubricating composition can be attributed to its novel rust inhibitor system.

In various Office Actions, the Examiner has stated it is *prima facie* obvious to combine two ingredients, each of which is targeted by the prior art to be useful for the same purpose. However, a *prima facie* obvious rejection cannot stand when the claimed invention produces a surprising result as it does in the present case. As confirmed by the submitted affidavit, the claimed lubricating composition comprising the novel rust inhibitor system exhibits a surprising result- superior rust performance. Thus, the *prima facie* obvious rejection which is the basis of the first and second rejections above should be withdrawn.

With the affidavit dictating the withdrawal of the first and second rejections, only the third rejection remains standing. The third rejection is based on the ground of nonstatutory obviousness-type double patenting. Properly executed terminal disclaimers overcome rejections based on nonstatutory obviousness-type double patenting. Along with the appeal brief, we submitted a properly executed terminal disclaimer which overcomes the nonstatutory obviousness-type double patenting. Therefore, the affidavit and the terminal disclaimer result in all the standing rejections being overcome which is a requirement for filing an affidavit after appeal under 37 CFR 41.33.

B. Showing of good and sufficient reasons why the affidavit is necessary and was not earlier presented

At the outset of this prosecution, we believed our arguments that the claimed invention was a species patent covering a novel and not previously recited rust inhibitor system would be effective and that we would ultimately receive a species patent based on the arguments presented. In May 2008, it became clear that such would not be the case. At that point, we started locating data and running experiments to support our previous assertions. When we finished compiling the necessary data, we were in the midst of this appeal. Thus, it was not physically possible for us to submit the data included in the

affidavit any earlier than we did. For the abovementioned reasons, we have shown good and sufficient reasons why the affidavit is necessary and was not earlier presented which is a requirement for filing an affidavit after appeal under 37 CFR 41.33.

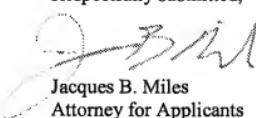
C. Affidavit filed prior to the date of filing a brief

In this instance, the Examiner could argue the affidavit was submitted along with the appeal brief and not before the brief. In our opinion, such an argument is not in the best interest of patent law policy for the following reasons. First, the affidavit was filed before the appeal brief was considered. Second, the affidavit clearly shows the claimed invention is a species patent which produces a surprising result and is therefore patentable. And third, it is not in the best interest of patent law policy for a clearly patentable invention to be denied a patent on the basis of a temporal technicality. In the interest of good patent policy, we respectfully ask the Examiner to enter the affidavit into the record.

Conclusion

In light of the remarks presented above, Applicants respectfully ask the Examiner to enter and consider the affidavit submitted with the appeal brief on April 2, 2009. Ultimately, this application should be allowed to issue.

Respectfully submitted,



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